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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/667,941 | 09/22/2003 | Andrew Walker | P-US-CS 1144 | 1634 |

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EXAMINER

KYLE, MICHAEL J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3676

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|-------------------------------------|--------------------------------------|--------------------------------------|--|
| <p>Office Action Summary</p> | Application No. 10/667,941 | Applicant(s) WALKER ET AL. | |
| | Examiner Michael J Kyle | Art Unit 3676 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/22/03, 6/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flexible sheet formed of a plurality of layers, as recited in claim 3, and the upper and lower layers of flexible film, as recited in claim 8, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

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3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Terminology for the upper and lower layers of flexible film cannot be found in the specification.

Claim Objections

4. Claim 1 is objected to because of the limitation, “between a said clamping member” in the next to last line of the claim. Examiner suggests deleting “a”.

5. Claims 2 and 3 are objected to because it is unclear how the gaseous vibration damping medium is retained between the support and a single thickness of the sheet, when the sheet is to have multiple layers as recited in claim 3. It is unclear if the multiple layers, as a whole, still constitute a single thickness of the sheet, or if each layer is a sheet thickness.

6. Claim 7 is objected to because of the limitation that the cover piece is made of a material that is relatively hard compared to the gaseous vibration damping medium. The term “relatively” implies that the gaseous vibration damping medium has a hardness also. Hardness is not a property of a gas. As such, any material is hard when compared to a gas.

7. Claim 8 is objected to because it is unclear what the first upper and lower layers of flexible film are. This terminology cannot be found in the specification, nor can a discussion of features even similar to these.

8. Claim 14 is objected to because of the recitation of “a gaseous vibration damping medium”. It is unclear if this is the same “gaseous vibration damping medium” that is recited in claim 13, from which claim 14 depends. As best understood by examiner, it is. If this is the

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case, then “a” should be change to --the-- or --said--, in the phrase that is objected to in this claim.

9. All claims depending from the above claims that are objected to, are also objected to, as they include all the limitations of the claims from which they depend.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLuca et al (“DeLuca”, U.S. Patent No. 6,591,456). Examiner notes that the limitation in the preamble, “for a power tool comprising a housing and a motor within the housing...” is an intended use recitation. As long the prior art is *capable* of being used for the intended purpose, then it is considered to read on the claim. DeLuca discloses a gripping portion used on a tool, comprising at least one flexible member (100, 102, 202) and a clamping member (230, 250, 256) having an aperture (254) so that the clamping member clamps the flexible member to the housing (112, 114, 118). A gaseous vibration damping medium (column 12, lines 20-21) is retained between the flexible member and the housing. The flexible member protrudes through the aperture (column 8, lines 20-31), and substantially none of the vibration damping medium is located in use between the clamping member and the housing (with the arrangement shown in figure 2,

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column 9, lines 25-35). Examiner asserts that DeLuca's gripping portion is capable of being used on a power tool having a housing with a motor therein, for actuating an output member of the tool.

10. With respect to claim 2, DeLuca discloses a gripping portion, that is capable of being used with a power tool, as discussed in the rejection of claim 1 above, where the gripping portion comprises at least one flexible sheet (172) and at least one support (112, 114). The flexible sheet is adapted to be mounted to the support to retain gaseous vibration damping medium (column 12, lines 20-21) between the support and a single thickness of the sheet. Examiner notes that layer 172 is single thickness. The gaseous medium (108) is retained between this and the support as claimed.

11. With respect to claims 3-5, the flexible sheet has a plurality of layers (172, 174), and the support forms part of the housing (112, 114). The gaseous medium is air (column 12, line 29).

12. With respect to claim 8, DeLuca discloses a gripping handle comprising a housing (112, 114, 118) and an assembly (100, 102, 202) disposed on the housing including a chamber (106, 206) enclosing a gaseous vibration damping medium (column 12, lines 20-21) between upper and lower (172, 174) flexible films. DeLuca further shows a cover piece (230, 250, 256) with an aperture (254), where the cover piece defines the outer surface of the handle, and the chamber (106, 206) protrudes through the aperture.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6, 7, and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wadge (U.S. Patent No. 6,206,107) in view of DeLuca. With respect to claims 6 and 7, Wadge discloses a power tool having a housing (4) with a handle (10) and a motor to actuate an output member of the tool. The handle includes a gripping portion (area to be gripped by user). Wadge fails to disclose the chamber enclosing a gaseous vibration damping medium, as claimed.

15. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21) extending outwardly from the gripping portion so that the gripping portion and the chamber may be simultaneously gripped. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca's arrangement further includes a cover piece (230, 250, 256) made of a material that is relatively hard as compared to the gaseous vibration damping medium. Examiner notes that any material will be relatively hard compared to a gas. The cover piece includes an aperture (254) through which the chamber protrudes.

16. With respect to claims 9-11, Wadge discloses a power drill (shown in figure 4) comprising a main body (4), a handle (10) having opposite side surfaces (6, 8) each defining gripping regions. Wadge fails to disclose the two chambers as claimed.

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17. DeLuca teaches two chambers (106) enclosing a gaseous vibration damping medium, one chamber protruding outwardly from the gripping region of each opposite side surface. The chambers are discrete from each other. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca also teaches four chambers.

18. With respect to claim 11, DeLuca discloses a single cover piece, but neither Wadge nor DeLuca show two cover pieces. However, replacing a single piece with multiple parts that act identical to the single piece is considered obvious and well known in the art. Such a change produces no new or unexpected result. It would have been obvious to one having ordinary skill in the art at the time of the invention to replace the single cover piece of DeLuca with a two cover pieces.

19. With respect to claims 12-14, Wadge discloses a power sander (column 5, line 1) comprising a housing with a main body (4) and upper gripping portion (on 10), a drive motor (22) in the main body, a sanding platen (sander attachment piece, not shown) extending downwardly from the main body and being driven by the drive motor. The handle (10) extends rearwardly from the main body. Wadge fails to disclose the chamber as claimed.

20. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21).

DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would

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have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user. DeLuca also teaches four chambers. As a result of the combination, the chamber of DeLuca will protrude from an upper surface of the gripping portion of Wadge. DeLuca further shows two chambers enclosing the gaseous vibration damping medium.

21. With respect to claim 15, Wadge discloses a power saw (column 5, line 1, "jigsaw") comprising a main body (4) with an opening (18) therethrough to define a handle (10) rearwardly of the opening, the housing adapted to receive a saw blade at a forward end. A motor (22) is disposed in the main body. The handle includes a gripping portion. Wadge fails to disclose the chamber as claimed.

22. DeLuca teaches a tool with a gripping portion where the gripping portion includes a chamber (106) enclosing a gaseous vibration damping medium (column 12, lines 20-21) extending outwardly from the gripping portion so that the gripping portion and the chamber may be simultaneously gripped. DeLuca uses the arrangement to provide a cushioning effect for the user (abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wadge as taught by DeLuca, such that Wadge includes the chamber arrangement of DeLuca, in order to provide a cushioning effect for the user.

Conclusion

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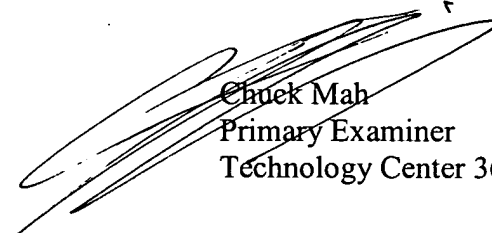
23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show that state of the art with respect to cushioned gripping portion and tools: Michel, Good et al, Huang, Kam, Chang, Habermehl, Hua, Wolf, Rachelbacher, and Zaidman.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk



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